

REMARKS/ARGUMENTS

Claims 1-3, 8-11, 14-16 and 18 remain in this application. Claims 4-7, 12-13 and 17 have been withdrawn in view of the examiner's earlier restriction requirement. Applicant retains the right to present claims 4-7, 12-13 and 17 in a divisional application.

Claims 1, 2 and 8 have been amended to clarify the structural feature of the case that allowed the originally claimed function of storing at least one compact disc. Claim 14 has been rewritten in independent form. Claims 16, 17 and 18 have been amended to incorporate language from the preamble of the claim into the body of the claim.

I. THE REJECTION UNDER 35 U.S.C. §112

The examiner rejected claim 14 under 35 U.S.C. §112, second paragraph, as being indefinite because it depends from non-elected claim 12. Claim 14 has been rewritten in an independent form to include all of the limitations of claim 12 and, thus, overcome the examiner's rejection of the claim.

II. THE REJECTIONS UNDER 35 U.S.C. §102(b)

A. The Rejection of Claims 1-10 Over Najmi

The examiner rejected claims 1-10 under 35 U.S.C. §102(b) as being anticipated by Najmi (Patent no. 5,845,777). The examiner argues that Najmi discloses a "beverage container 15 ... with a case defined by ring 16 affixed to the container base" and that "[s]ince the ring is circular it is taken to be capable of the function claimed."

The present invention is directed to a case for storing a compact disc wherein the case is affixable to the base of a beverage container. Applicant has amended Claim 1 to clarify a structural feature, a central post, which facilitates the case being used for storing a compact disc. The "case defined by ring 16" of Najmi does not contain a central post. Therefore, Najmi does not anticipate Claim 1.

Claims 2, 8, and 10 depend from Claim 1 and Claims 3 and 9 further depend from Claim 2. Since amended Claim 1 is not anticipated by Najmi, Claims 2, 3, 8, 9 and 10 cannot be anticipated either. Furthermore, the examiner has acknowledged that Claims 2, 3, 8 and 9 are directed to allowable subject matter.

Claims 4-7 were withdrawn as a result of an earlier restriction requirement.

B. The Rejection of Claims 1 and 15 Over Nedblake, Jr.

The examiner rejected claims 1 and 15 as being anticipated by Nedblake, Jr. (Patent no. 5,664,671). As to claim 1, the examiner argues that Nedblake, Jr. discloses "[a] beverage container 12 ...with a case defined by container/housing 14 affixed to the container base" and that "[s]ince the case can accommodate ... a hamburger, [it] is taken to be capable of the function claimed." As discussed in section IIA above, Applicant has amended Claim 1 to clarify a structural feature, a central post, which facilitates the case being used for storing a compact disc. The "container/housing 14" of Nedblake, Jr. does not contain a central post, nor does it even suggest that a central post may be used. Therefore, Nedblake, Jr does not anticipate Claim 1.

As to claim 15, the examiner argues that a slot may be formed in the case taught by Nedblake, Jr. by the "removal of cover 34 of case 14 where the bottom section 32 has an upper edge forming an aperture for insertion of the product." Applicant respectfully disagrees with the examiner, as simply removing cover 34 from the case will not form a slot for insertion of the product. In the package taught by Nedblake, Jr., the case has a cover 34 and a lower section 32. The upper surface of the cover mates with and engages base 20 of the beverage container. Once the case is engaged with the beverage container, it is held into place by a coupling band 16 of shrink-wrap. If cover 34 is removed from the case, then sidewalls 42 of lower section 32 must mate with base 20 of the beverage container. In order to keep sidewalls 42 mated with base 20, the coupling band 16 of shrink-wrap must be used. The shrink-wrap would hold the sidewalls 42 tight to the base 20 and would fill in any minor gaps created between the two. Therefore, there could not possibly be an aperture formed between the sidewalls of the case and the base of the beverage container in which a product may be inserted. Since the case taught by Nedblake, Jr. could not have a slot, as claimed in the present application, Nedblake, Jr does not anticipate Claim 15.

C. The Rejection of Claims 16 and 18 Over Cowan

The examiner rejected claims 16 and 18 as being anticipated by Cowan (Patent no. 6,024,214). The examiner characterized the container taught by Cowan as "a compact disc case having a protective housing formed by top and bottom members 40, 43 enclosing the tray 42." Cowan does not disclose or suggest that

the compact disc case may be adapted for affixation to the base of a beverage container as recited in amended Claims 16 and 18 of the present invention. Therefore, claims 16 and 18 cannot be anticipated by Cowan.

III. THE REJECTIONS UNDER 35 U.S.C. §103

The examiner rejected claim 11 under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Nedblake, Jr. (Patent no. 5,664,671). Claim 11 depends from amended claim 1. As described in section II B above, The "container/housing 14" of Nedblake, Jr. does not contain a central post, nor does it even suggest that a central post may be used. Nedblake is directed to a container for housing an edible solid, such as a sandwich and does not contemplate or suggest a compact disc. Accordingly, Nedblake can provide no motivation to incorporate a central post within "container/housing 14" because inclusion of such a post could possibly deform or damage the edible solid stored within the housing. If anything, Nedblake actually teaches away from incorporating a central post into the housing. Therefore, Claim 11 cannot be anticipated or obviated by Nedblake, Jr.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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